



RECEIVED
JUL 09 2003
TC 1700

1 of 3

AF/1700

\$

✓

13

d.p.

7/9/03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Carlos Ernesto KOSTER

Serial No.: 09/623,008

Filing Date: 24 August 2000

Title: METHOD OF TREATMENT OF GOODS
WITH CARBON DIOXIDE AND NITROGEN

Group No.: 1744

Examiner: M. Chorbaji

APPEAL BRIEF UNDER 37 C.F.R. 1.192

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants herewith file, in triplicate, an Appeal Brief in the above-identified case, pursuant to their Notice of Appeal of 30 April 2003, under 37 C.F.R. 1.192.

I hereby certify that this correspondence (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450 on

30 June 2003

30 June 03
Date

Roland W. Morris
Signature

ASA-101

1

RWN/I

07/07/2003 MBERHE 00000035 09623008

01 FC:2402

160.00 0P

1. REAL PARTY IN INTEREST

The real party in interest is the applicant, Carlos Ernesto Koster.

2. RELATED APPEALS AND INTERFERENCES

Applicant is not aware of related appeals or interferences with regard to the present application.

3. STATUS OF CLAIMS

The application was originally filed with Claims 1-4. Claim 5 was added by the First Preliminary Amendment at the time of filing. Claims 1-4 were amended by the First Preliminary Amendment at the time of filing. Claims 1, 3, and 5 were amended by Amendment A of 01 February 2002 (paper no. 8), responsive to the first Office Action of 06 November 2001 (paper no. 7). Claims 2 and 4 were canceled by the Amendment A. The Claims remaining under consideration (i.e., pending) are 1, 3 and 5. Claims 1, 3 and 5 stand rejected under 35 U.S.C. §103(a). The rejection of all Claims is appealed.

4. STATUS OF AMENDMENTS

No Amendments after Final Rejection were filed after the Final Office Action of 30 January 2003.

5. SUMMARY OF INVENTION

Claims 1 and 5 have limitations directed to a method of treatment of goods by the application of carbon dioxide and nitrogen derived from the source of motive power for a transportation vehicle in which the goods are stored.

Claim 3 has limitations directed to a method of treatment of goods by the application of carbon dioxide and nitrogen derived from boiler exhaust in an oil extraction plant in which the goods are stored. Thus the claims present species of a method which utilizes exhaust gases of an on-site combustion system not previously adapted to provide for the treatment of the goods.

The invention is summarized in the Abstract of the Disclosure (First Preliminary Amendment at page 5)

[A] Method for the treatment of goods with carbon dioxide and nitrogen at the site where the goods are stored. Carbon dioxide and nitrogen gas sources available at the sites are treated to obtain the carbon dioxide and nitrogen, such as by separation from engine combustion products in the case where the goods are located on a ship.

6. ISSUES

The issue presented for review is as follows:

Is the Examiner correct in maintaining a rejection under 35 U.S.C. §103(a), of Claims 1, 3 and 5 as obvious over Banks et al. (U.S. Patent 5,300,265; hereinafter “Banks”) in view of Fiorenzano, Jr., (U.S. Patent 5,326,543; hereinafter “Fiorenzano”)?

7. GROUPING OF CLAIMS

The group of Claims 1 and 5 is to be considered as a separate group from the group of Claim 3 and the claim groups are not intended to stand or fall together.

8. ARGUMENT

Is the Examiner correct in maintaining a rejection under 35 U.S.C. §103(a), of Claims 1, 3 and 5 as obvious over Banks et al. (U.S. Patent 5,300,265; hereinafter “Banks”) in view of Fiorenzano, Jr., (U.S. Patent 5,326,543; hereinafter “Fiorenzano”)?

It is the assertion of the Office in paper 11 (paragraph 3 of the Detailed Action) that while Banks fails to disclose the claimed arrangement of exhaust gas treatment of the present invention, Fiorenzano supplies the missing motivation to produce the present invention by disclosing the use of nitrogen and carbon dioxide gases to treat goods located in ships. The Detailed Action further states that, because boilers are integral parts of motive power for a ship, a person having ordinary skill in the art would be motivated to combine the Banks and Fiorenzano references to produce the presently claimed invention.

Applicant respectfully believes the outstanding rejections are incorrect because the disclosure of Fiorenzano has been mischaracterized by the Office. Thus the Office has failed to establish a *prima facie* case of obviousness.

Fiorenzano, contrary to the assertions of the Office, actually teaches away from the use of nitrogen and carbon dioxide gases, stating that the use of nitrogen and carbon

dioxide gases is a part of the prior art which Fiorenzano does not use (col. 1, line 43). Instead, Fiorenzano seeks to replace and improve upon the use of nitrogen and carbon dioxide gases by teaching a system in which all particles within the air of a storage system are oxidized through the use of heat (col. 3, line 39) or UV light (col. 3, line 48).

Thus, the proffered motivation for a combination of the references fails to establish that the motivation for combining Banks and Fiorenzano comes from the art itself, as required. Instead, such a motivation appears to be a *post hoc* rationalization made with the present invention firmly in mind.

Further contrary to the assertions of the Office, Fiorenzano does not teach that its electrical heating coils or UV lamps, used to oxidize particles within the storage air, are in any way related to a source of motive power for a containment vessel or boiler operations for an oil extraction operation. Thus, no teaching exists within the references themselves, singly or in combination, that would lead a person of ordinary skill in the art to produce the present invention. Again, any suggestion for such a combination is clearly a *post hoc* rationalization made with the present invention firmly in mind.

Each of the claim groupings as set forth above in Section 7 are believed to be separately patentable since the group of Claims 1 and 5 require the synergy of motive power/transport vessel/gas treatment, while Claim 3 does not require the transport vessel but requires a method pertaining particularly to the use of boilers in oil extraction processes for obtaining the nitrogen and carbon dioxide. In both cases, the requirements of a method according to each group are different and present distinct improvements to the prior art.

When viewed as a whole, it is clear that the present invention is non-obvious. It is further clear that the combination of the cited references is an untenable hindsight reconstruction of the present invention. The cited art provides no proper suggestion of the need for combining the references and no proper showing that such a combination would result in the claimed invention. The Board is therefore respectfully requested to overturn all rejections.

Serial No.: 09/623,008


9. APPENDIX

Appendix A, containing a copy of the claims involved in the appeal, is
attached hereto.

For all the foregoing reasons it is respectfully requested that the Board rule
in Applicants' favor and overturn the rejections of the claims at issue.

Favorable consideration is requested.

Respectfully submitted,



Roland W. Norris
Registration No. 32,799

Pauley Petersen Kinne & Erickson
2800 West Higgins Road; Suite 365
Hoffman Estates, Illinois 60195
TEL (847) 490-1400
FAX (847) 490-1403

APPENDIX A

1. (Twice Amended) A method for the treatment of goods with carbon dioxide and nitrogen comprising: generating said carbon dioxide and nitrogen at a location of said goods by washing, filtering, cooling and catalysing of other gas sources; and wherein said location of said goods is a transportation vessel, said transportation vessel having a source of motive power generating said other gas sources.

3. (Twice Amended) A method for the treatment of goods with carbon dioxide and nitrogen comprising: generating said carbon dioxide and nitrogen at a location of said goods by washing, filtering, cooling and catalysing of other gas sources, wherein said goods are located in oil extraction plants and the gas source of the carbon dioxide and nitrogen is obtained from an exhaust from at least one boiler in the oil extraction plants.

5. (Amended) A method for the treatment of goods with carbon dioxide and nitrogen according to claim 1, wherein said goods are located in a ship transportation vessel and the gas source of the carbon dioxide and nitrogen is a stack of said ship connected to said source of motive power for the ship.